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ZINUS, INC.

8
9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 SAN JOSE DIVISION

12 ZINUS, INC., a California corporation,

13 Plaintiff,
14 v.

15 SIMMONS BEDDING COMPANY, a
16 Delaware corporation, and DREAMWELL,
17 LTD., a limited liability company of
18 Nevada,

19 Defendants.

20 DREAMWELL, LTD., a limited liability
21 company of Nevada,

22 Counterclaimant,
23 v.

24 ZINUS, INC., a California corporation,

25 Counterdefendant.

26 Case No. 07-CV-03012 PVT

27
28 **ZINUS' MEMORANDUM IN
OPPOSITION TO DREAMWELL'S
BRIEF RE HYPOTHETICAL CLAIM
ANALYSIS**

Date: February 19, 2008
Time: 10:00 a.m.
Location: Courtroom 5
Judge: Hon. Patricia V. Trumbull

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1 **I. INTRODUCTION**

2 The Court has already found that Zinus' Swirl Wrap method does not literally
 3 infringe U.S. Patent No. Re 36,142 ("the '142 Patent"). The only remaining issue¹ is whether
 4 there can be infringement under the doctrine of equivalents.

5 As set forth previously by Zinus, there are three independent reasons why there can
 6 be no infringement under the doctrine of equivalents. If Zinus were to prevail on any one of
 7 the three, then Zinus' Swirl Wrap method cannot be found to infringe under the doctrine of
 8 equivalents. The three reasons are: (1) applying the doctrine of equivalents to the "inserting
 9 . . . into" claim element is barred due to prosecution history estoppel, (2) the scope of
 10 equivalency of the "inserting . . . into" element cannot be expanded so far as to encompass
 11 the Swirl Wrap method because doing so would result in the expanded right to exclude
 12 covering the prior art method of U.S. Patent No. 4,711,067 to Magni (the "Magni patent"),
 13 and (3) "inserting . . . into" is not the equivalent of "rolling up" under the insubstantial
 14 differences test (function/way/result).

15 Zinus submits that the cleanest and easiest way for the Court to dispose of the
 16 doctrine of equivalents issue is to find that the doctrine of equivalents is barred due to
 17 prosecution history estoppel. Such a finding can be made, as a matter of law, looking only at
 18 the intrinsic evidence. Each element contained in a patent claim is deemed material to
 19 defining the scope of the patented invention, and thus the doctrine of equivalents must be
 20 applied to individual elements of the claim, not to the invention as a whole. A hypothetical
 21 claim analysis cannot operate to the exclusion of the doctrine of prosecution history estoppel
 22 or the All Limitations Rule. *Moore USA, Inc. v. Standard Register Co.*, 229 F.3d 1091, 56
 23 USPQ2d 1225 (Fed.Cir. 2000).

24 The Court, however, has ordered the parties to brief the "hypothetical claim" analysis
 25 set forth in *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677
 26 (Fed.Cir. 1990). Before engaging in this exercise, Zinus wishes to point out that the
 27 hypothetical claim procedure helps identify an outer limit, imposed by the prior art, of how
 28

1 far the doctrine of equivalents can expand the right to exclude. The hypothetical claim
 2 analysis that identifies this outer limit is not, however, a substitute for the insubstantial
 3 differences test (or the associated function/way/result test). The insubstantial differences test
 4 is a separate and independent requirement for establishing infringement under the doctrine of
 5 equivalents.

6 In its Opening Brief re Hypothetical Claim Analysis (“Hypothetical Claim Brief”),
 7 Dreamwell proposes a hypothetical claim. Dreamwell has not, however, met its burden of
 8 proving the patentability of the hypothetical claim. The Court of Appeals for the Federal
 9 Circuit has held that the burden of proving patentability rests with the patentee:

10 “It is well settled law that a patentee cannot assert a range of equivalents that
 11 encompasses the prior art. *Wilson Sporting Goods Co. v. David Geoffrey &*
Assocs., 904 F.2d 677, 683, 14 USPQ2d 1942, 1948 (Fed. Cir. 1990). To test this
 12 limit, the notion of a hypothetical claim may be useful. *904 F.2d at 684*, 14
 13 USPQ2d at 1948. A hypothetical claim may be constructed to literally cover the
 14 accused device. *Id.* If such a claim would be unpatentable under 35 U.S.C. §§ 102
 15 or 103, then the patentee has overreached, and the accused device is noninfringing
 16 as a matter of law. *904 F.2d at 683-84*, 14 USPQ2d at 1948. The burden of
 17 producing evidence of prior art to challenge a hypothetical claim rests with an
 18 accused infringer, but the burden of proving patentability of the hypothetical
claim rests with the patentee. *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d
 19 974, 984, 50 USPQ2d 1515, 1521 (Fed. Cir. 1999).” [*Interactive Pictures Corp. v.*
Infinite Pictures, Inc., 274 F.3d 1371, 61 USPQ2d 1152 (Fed.Cir. 2001)]

20 Dreamwell’s hypothetical claim is unpatentable under both 35 U.S.C. §103 and 35
 21 U.S.C. §112. Therefore, the Patent Office would not allow Dreamwell’s hypothetical claim.

22 **II. HYPOTHETICAL CLAIM AND DREAMWELL’S ARGUMENT**

23 Dreamwell’s Hypothetical Claim Brief actually proposes two alternative hypothetical
 24 elements to take the place of the claim element “inserting . . . into said containment sleeve
 25 . . . for shipment”. Dreamwell’s two alternative hypothetical claim elements are:

26 (1) “inserting said evacuation tube into a pre-cut, solid cover or barrier of
 27 flexible material that substantially covers the exposed surface of the
 28 mattress assembly and which is dimensioned or configured, including by
 use of tape, adhesives or fasteners, to retain said compressed mattress
 assembly in a compressed state for shipment.”

¹ Concerning Zinus’ Motion for Summary Adjudication of Non-Infringement, filed on October 2, 2007.
 ZINUS’ MEMORANDUM IN OPPOSITION
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(2) "positioning said evacuation tube within a pre-cut, solid cover or barrier of flexible material that substantially covers the exposed surface of the mattress assembly and which is dimensioned or configured, including by use of tape, adhesives or fasteners, to retain said compressed mattress assembly in a compressed state for shipment."

Dreamwell has two basic arguments as to why its hypothetical claim is patentable over Magni. First, the hypothetical claim recites that each spring of the mattress assembly being compressed is contained within its own individual pocket of fabric. According to Dreamwell, Magni does not disclose this, and for this reason the hypothetical claim is patentable over Magni. Second, the hypothetical claim recites that the compressed mattress assembly is inserted into a “pre-cut, solid cover or barrier of flexible material” that “substantially covers the exposed surface of the mattress assembly” (emphasis added). According to Dreamwell, Magni does not disclose either the “pre-cut” aspect or a “solid cover or barrier” that “substantially covers the exposed surface of the mattress assembly”. For these reasons as well, Dreamwell asserts that the hypothetical claim is patentable over Magni.

Zinus respectfully disagrees. Dreamwell's hypothetical claim is unpatentable under both 35 U.S.C. §103 and 35 U.S.C. §112. Therefore, the Patent Office would not allow Dreamwell's hypothetical claim.

III. THE HYPOTHETICAL CLAIM IS NOT PATENTABLE

A. “Pocketed Coil Springs” Does Not Make The Hypothetical Claim Patentable.

Dreamwell's first argument for patentability of the hypothetical claim is that the hypothetical claim would have been patentable over Magni because the hypothetical claim recites that the mattress assembly that is being compressed is "constructed of pocketed coil springs" "wherein each spring is contained within an individual pocket of fabric".

Dreamwell argues that the “pocketed coil springs” limitation renders the hypothetical claim non-obvious over Magni because Magni does not disclose an innerspring mattress with such individual pocketed coils. Dreamwell’s argument is a loser because the Patent Office has already rejected it. Dreamwell has even admitted that the Patent Office determined that the

1 limitation of packaging “pocketed” coils did not distinguish the claims over packing generic
 2 spring mattresses. Dreamwell admitted:

3 “The applicants also argued in this Amendment that ‘[i]n an effort to
 4 distinguish even more clearly over Broyles, claim 1 has been amended
 5 herein to specifically recited a method of packaging *pocketed* coils.’ [Exh.
 6 W-F (emphasis in original)] To support their argument that a mattress
 7 assembly in which each spring is contained within an individual pocket of
 8 fabric differs significantly from other types of mattresses (such as the
 9 Broyles mattress), the applicants submitted the Declaration of co-inventor
 Ricky F. Gladney. . . .

7 **Notwithstanding these arguments, the Patent Office issued a ‘final
 8 rejection’ of all claims in light of the Broyles patent, reasoning in
 9 relevant part that ‘Broyles shows a containment sleeve 43 holding the
 springs in a compressed state.’”** [Dreamwell’s Opposition to Zinus’
 Motion for Summary Adjudication, 4:6-19 (bold emphasis added)]

10 The Examiner confirmed that adding the “pocketed” coil limitation did not render the claims
 11 non-obvious over packing any type of compressible material. The declaration of the co-
 12 inventor also claimed that pocketed coils provided unexpected results. The Examiner did not
 13 find this secondary consideration sufficient to warrant patentability, and the Examiner
 14 rejected this argument. The Examiner stated, “Applicant’s arguments filed 1/22/96 have
 15 been fully considered but they are not deemed to be persuasive. . . . Regarding the actual
 16 product that is being compressed, Broyles clearly shows the manipulative steps to package a
 17 resiliently compressible article. Broyles operation could package the product of the invention
 18 to a compressible state; therefore, little patentable weight is given to the actual product since
 19 the manipulative steps of Broyle could package any type of compressible material.” [Office
 20 Action dated 3/26/96 in application 08/416,065, 2:23-3:8 (emphasis added)] In addition, the
 21 Advisory Action dated 7/23/96 suggests that the ultimate reason for patentability of the
 22 claims in the file wrapper continuing application 08/694,803 related to the final two claim
 23 elements and not to the “pocketed” coil limitation or to the secondary consideration of
 24 unexpected results. The Advisory Action states that claim amendments raised new issues
 25 that required further consideration because “[t]he 2 final steps were never considered before
 26 since the steps are directed towards opening the package.” The two steps of opening the
 27 package have nothing to do with the unexpected results of compressing pocketed coil
 28 springs.

1 In the prosecution of the parent cases of the ‘142 Patent, the Patent Office rejected the
 2 applicants’ argument that packing pocketed coils is non-obvious over packing generic spring
 3 mattresses. Especially with the more stringent standard for overcoming obviousness recently
 4 enunciated by the Supreme Court in *KSR v. Teleflex*, the Patent Office would not now find
 5 otherwise. The Patent Office would not find the hypothetical claim to be nonobvious over a
 6 method for packing generic spring mattresses simply because the hypothetical claim includes
 7 the limitation “pocketed coil springs”. The Patent Office would not now find that pocketed
 8 coil springs provide sufficient unexpected results to warrant patentability when the Examiner
 9 rejected this argument in the original prosecution.² Therefore, the “pocketed coil springs”
 10 limitation does not render Dreamwell’s hypothetical claim patentable.

11 Dreamwell nevertheless argues in its Hypothetical Claim Brief that an example³ in
 12 Magni that follows a generic teaching somehow would have taught one of ordinary skill
 13 away from using the Magni methods on an innerspring mattress with individual pocket coils.
 14 [Hypothetical Claim Brief, 7:18-22] This is incorrect because the specific example of foam
 15 mattresses in Magni follows a generic teaching, and Magni elsewhere refers to “the packing
 16 of spring mattresses”. [Magni, 1:17-18]

17 The statement from Magni quoted by Dreamwell is only a generic statement, as
 18 Dreamwell admits. Dreamwell acknowledges that the Magni patent “generically states” that
 19 the Magni methods “may be adopted for many types of mattresses”. The general
 20 applicability of the generic teaching of Magni is not limited to the specific examples that
 21 follow the generic teaching. Nothing in Magni suggests that its packaging method could not
 22 be applied to “packing of spring mattresses or other modern type mattresses made with
 23 synthetic resin foam or other materials”. [Magni, 1:17-19 (emphasis added)] Moreover, the
 24

25 ² Dreamwell’s assertion that there is “compelling evidence that the specific application of the
 26 patented compression and packaging techniques to pocketed coil innerspring mattress assemblies
 27 was a meaningful and non-obvious advance in the relevant art” is simply false. [Hypothetical Claim
 Brief, 15:9-12] The prosecution history proves the contrary.

28 ³ “. . . particularly for those which have an intermediate layer of rubber or a synthetic elastic foam
 resin and, possibly, outer layers of artificial or natural fibres on the surfaces ensuring the comfort of
 the user.” (Magni, 2:5-9)

1 generic suggestion quoted by Dreamwell is made not to an “automaton”, but rather to a
 2 creative person, who has experience with mattresses, and who is capable of fitting together
 3 multiple teachings. As previously set forth in detail in Zinus’ Reply to Dreamwell’s
 4 Opposition⁴, the Supreme Court recently stated in *KSR International Co. v. Teleflex Inc.*, 127
 5 S.Ct. 1727, 1740, 82 USPQ2d 1385 (2007) that the person of ordinary skill has “ordinary
 6 creativity”, and is “not an automaton.” The Supreme Court stated:

7 “[I]n many cases, a person of ordinary skill will be able to fit the teachings
 8 of multiple patents together like pieces of a puzzle. . . . A person of
 9 ordinary skill in the art is also a person of ordinary creativity, not an
 10 automaton.” *KSR v. Teleflex*, 127 S.Ct. at 1742.

11 Here, where the Magni patent actually refers to “packing of spring mattresses” and suggests
 12 generic use “for many types of mattresses”, not even ordinary creativity would have been
 13 required to apply the Magni method to another type of mattress, e.g., a pocketed coil
 14 innerspring mattress. The Supreme Court has confirmed that one of ordinary skill can
 15 implement a predictable variation⁵. Accordingly, when the familiar obviousness framework
 16 of *Graham* and *KSR* are properly applied, it is clear that one of ordinary skill reading the
 17 Magni patent would have had the minimal amount of creativity and common sense necessary
 18 to recognize, in view of the suggestion in Magni, that the Magni method applies to other
 19 types of mattresses such as pocketed coil springs mattresses. The Patent Office would not
 20 determine that the “pocketed coil spring” limitation of the hypothetical claim patentably
 21 distinguishes⁶ the hypothetical claim from the Magni prior art under 35 U.S.C. §103 because
 22 the Patent Office already determined that the “pocketed coil spring” limitation has
 23 insufficient patentable weight to be distinguishable over the spring mattress of Broyles.

24 ⁴ Plaintiff Zinus, Inc.’s Reply To Dreamwell’s Opposition To Plaintiff’s Motion For Summary
 25 Adjudication Of Non-Infringement, filed November 27, 2007.

26 ⁵ “When a work is available in one field of endeavor, design incentives and other market forces can
 27 prompt variations of it, either in the same field or a different one. If a person of ordinary skill can
 28 implement a predictable variation, 35 U.S.C. 103 likely bars its patentability.” *KSR v. Teleflex*, 127
 S.Ct. at 1740.

⁶ Zinus is mindful that the hypothetical claim is to be considered as a whole, but for ease of
 explanation and organization in this memorandum, each recitation that is argued by Dreamwell to
 distinguish the prior art is discussed separately.

1 B. The “Solid Cover or Barrier of Flexible Material” Recitation Renders The
 2 Hypothetical Claim Invalid Under 35 U.S.C. §112, ¶1.

3 The claims of the ‘142 Patent all recite a step of inserting the evacuated tube into a
 4 “containment sleeve”. As Zinus has explained in prior briefing, the Swirl Wrap method does
 5 not involve a sleeve, but rather involves rolling a compressed mattress up with a sheet of
 6 flexible film as disclosed in the Magni patent. The Magni patent teaches performing this
 7 rolling in an assembly line manufacturing process whereby a compressed mattress is rolled
 8 up with a length of film that is being dispensed from a reservoir spool 220 (see Magni, Figs.
 9 9 and 10). Then, after the mattress is rolled up (see Magni, Fig. 19) with the length of the
 10 film 222, the length of film is severed from the remainder of the film on the reservoir spool.
 11 In the Swirl Wrap method, on the other hand, a compressed mattress is simply rolled up with
 12 a rectangular sheet of film. The resulting rolled-up mattress products in both the Magni and
 13 Swirl Wrap methods are the same, but the Magni patent discloses a mechanized assembly
 14 line process whereby the film is cut after rolling.

15 Dreamwell, recognizing a slight difference between the Magni method and Swirl
 16 Wrap method, now seeks in its hypothetical claim to remove the problematical “sleeve”
 17 limitation and to substitute a very broad recitation of a “solid cover or barrier of flexible
 18 material”. Just broadening the claim in this way, however, would leave the hypothetical
 19 claim reading on the prior art Magni method. Dreamwell therefore adds the term “pre-cut” in
 20 an attempt to distinguish the hypothetical claim from Magni, and at the same time to cover
 21 Zinus’ Swirl Wrap method.

22 Dreamwell’s scheme fails, however, because the ‘142 Patent fails to satisfy the
 23 written description requirement of 35 U.S.C. §112, first paragraph, for the contrived
 24 hypothetical claim. 35 U.S.C. §112, first paragraph, requires that a patent specification
 25 provide objective evidence that the inventor had possession of the full scope of the claim.
 26 *Lizardtech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1344-1345, 76 USPQ2d
 27 1724 (Fed.Cir. 2005). In the case of the ‘142 Patent, only one object is disclosed into which
 28 the “evacuated tube” is “inserted”, and this object is a tube. It is referred to as a sleeve and a

1 tube. It is illustrated as a sleeve and a tube. The '142 Patent states that the containment
 2 sleeve "preferably" "is an extruded tube of 4 mil polyethylene" ('142 Patent, 3:25-26).

3 Very importantly, nowhere in the '142 Patent is there any objective evidence that the
 4 inventors ever conceived of their containment sleeve being anything other than a tube.
 5 Nowhere in the '142 Patent is there any objective evidence that the inventors thought that, or
 6 knew that, the containment sleeve need not be a tube, but rather could be just a sheet of
 7 material. Moreover, nowhere in the '142 Patent is there any objective evidence that the
 8 inventors thought that, or knew that, such a sheet of material could be or should be rolled up
 9 with a compressed mattress. The term rolling or roll-up nowhere appears in the '142 Patent.
 10 Nowhere in the '142 Patent is there any disclosure of rolling anything up, much less rolling
 11 up a mattress.

12 Dreamwell's overly broad hypothetical claim, on the other hand, now encompasses a
 13 method involving rolling a sheet of material up with a compressed mattress, even though the
 14 '142 Patent utterly fails to provide any objective evidence whatsoever that the inventors had
 15 possession of, or ever conceived of, rolling a mattress in any way or rolling a sheet up with
 16 any object. The '142 Patent therefore fails to provide the necessary objective evidence that
 17 the inventors had possession of the full scope of the hypothetical claim as required by 35
 18 U.S.C. §112, first paragraph. As such, the Patent Office would have rejected Dreamwell's
 19 hypothetical claim for violating the written description requirement of 35 U.S.C. §112, first
 20 paragraph. Dreamwell is simply not entitled to such a broad hypothetical claim under the
 21 *Wilson Sporting Goods* analysis because such a broad claim is not supported by the
 22 specification of the '142 Patent.

23 C. "Solid Cover or Barrier of Flexible Material" Does Not Make The Hypothetical
 24 Claim Patentable.

25 Dreamwell argues at length that Magni's use of the term "ribbon-shaped film" to
 26 describe film 222 means that the film 222 is "a narrow strand of film that is significantly
 27 narrower than the width of the mattress". [Hypothetical Claim Brief, 10:5-7]. Dreamwell
 28 states that "there is substantial evidence that the Magni patent discloses not a solid sheet of

1 film that substantially covers the exposed surface of the mattress as Zinus claims, but rather a
 2 long, narrow film that resembles a line and that is wrapped around the mattress at least once”
 3 [Id., 13:23-14:2]. Presumably it was Dreamwell’s mistaken belief that Magni’s ribbon-
 4 shaped film 222 was not as wide as Magni’s mattress M₉ that led Dreamwell to include into
 5 the contrived hypothetical claim the recitation that the “cover” is “solid” and “substantially
 6 covers the exposed surface of the mattress assembly”. Dreamwell states that the recitation in
 7 the hypothetical claim about the “solid cover or barrier” that “substantially covers the
 8 exposed surface of the mattress assembly” somehow distinguishes the Magni prior art
 9 because Magni (according to Dreamwell) does not disclose a solid sheet of film 222 that
 10 covers the entire exposed surface of the Magni mattress. [Hypothetical Claim Brief, 9:15-20]

11 The recitations in the hypothetical claim of the cover being “solid” and a “barrier”
 12 that “substantially covers the exposed surface of the mattress assembly” does nothing
 13 whatsoever to distinguish Magni. Magni discloses this subject matter. Magni discloses that
 14 the ribbon-shaped film is “rolled up at least partially together with said mattress and
 15 enveloping the rolled mattress”. [Magni, 2:46-48 (emphasis added)] Dreamwell has simply
 16 misread the Magni patent and refuses to admit the error. Alternatively, Dreamwell has
 17 knowingly misrepresented the disclosure of Magni in an attempt to fabricate an issue of
 18 material fact in a desperate attempt to postpone inevitable findings that should be determined
 19 by summary judgment. [Id., 9:1-2] The issue of whether film 222 is a “narrow strand” is not
 20 genuine.

21 In fact, Dreamwell has fabricated the notion that film 222 is “a narrow strand” and “a
 22 long, narrow strip of film resembling a thin line”. [Id., 10:6, 11:9-10] Dreamwell has
 23 fabricated the notion that multiple convolutions of film 222 criss-cross the compressed
 24 mattress in Figure 13 of Magni. [Id., 13:17-19] Nowhere does Magni state that film 222 is
 25 narrow, a thin line or a strand. There is no mention of criss-crossing in Magni. There is,
 26 however, disclosure in Magni that precludes film 222 from being narrow, a thin line or a
 27 strand or from criss-crossing mattress C in Figure 13. Dreamwell has chosen to ignore this
 28

1 disclosure in Magni and to argue based on dictionary definitions of “ribbon”.⁷ Using
 2 extrinsic evidence, such as dictionaries and deposition testimony, to contradict how the term
 3 “ribbon-shaped film” is used in Magni is improper.

4 Magni explains why film 222 is as wide as the two semi-mandrels 207 in Figure 14.
 5 Figure 14 shows that the two semi-mandrels 207 are as wide as cylinder 215. Figures 9 and
 6 10 show that cylinder 215 and spool 220 are wider than mattress C. Magni explains:

7 “Each semi-mandrel 207 is internally hollow to form a suction chamber
 8 through the holes 209 distributed along each semi-mandrel. . . .

9 A reservoir-spool 220 feeds a ribbon-shaped film 222, which is passed
 10 through guide means 224 located in the vicinity of the cylinder 215. The
 11 end of the film 222 may be approached to the mandrel formed by the
 12 coupled semi-mandrels 207, when the cylinder is lifted (FIG. 15) and
 13 when a vacuum has been created inside the two semi-mandrels. The end of
 14 the film 222 can thus be made to adhere by pneumatic suction against the
 15 mandrel.” [Magni, 5:50-6:6]

16 Thus, the film 222 adheres to the coupled semi-mandrels 207 by suction through the holes
 17 209 distributed along each semi-mandrel, as shown in Figure 14 of Magni. Film 222 cannot
 18 be a narrow strand because the holes would not create suction with a narrow strand.
 19 Moreover, the two semi-mandrels 207 do not move laterally with respect to the mattress as
 20 the mattress is rolled up inside the film. Therefore, Magni’s description of feeding the end of
 21 film 222 to the two semi-mandrels 207 and rotating the semi-mandrels to roll up the flattened
 22 mattress together with the film 222 is inconsistent with the film criss-crossing the mattress.

23 In its attempt to fabricate an issue of material fact, Dreamwell has also ignored
 24 standard technical drafting conventions. Dreamwell states, “while Zinus has asserted that the
 25 label C refers to a cover that lies underneath ribbon-shaped film 222, there would be no
 26 reason to label and depict the cover for the mattress and to show the pattern of the mattress if
 27 the cover and pattern were not visible after application of the ‘ribbon-shaped film 222.’”

28

29 ⁷ Dreamwell also incorrectly applies a principle of claim construction to the words “ribbon-shaped”.
 30 Dreamwell states that the usage of a term in one place provides guidance regarding the meaning of
 31 the same term in other places. [Hypothetical Claim Brief, 11:19-21] But Dreamwell applies this
 32 principle to the different terms “film” and “strings”. Dreamwell chooses to ignore that fact that
 33 Magni distinguishes between “ribbon-shaped film 222” and “ribbon-shaped strings 230”. [Magni,
 34 2:46-55] Under the tenets of claim differentiation, these different terms “ribbon-shaped film” and
 35 “ribbon-shaped string” are to be interpreted differently.

1 [Hypothetical Claim Brief, 13:14-19] Dreamwell chooses to ignore that the lead line to "C"
 2 in Figure 13 is dashed to indicate that the mattress C is beneath film 222. Dreamwell
 3 chooses to ignore that mattress C in Figure 10 has a dashed outline and a dashed lead line
 4 because mattress C is within wrapper P. The elastic masses M_7 and M_9 are also designated
 5 in Figure 10 with dashed lead lines to indicate that they are beneath other components. Thus,
 6 it is clear from the disclosure of Magni that Figure 13 does not show criss-crossing strands.

7 Despite Dreamwell's attempt to create a dispute of fact, Magni's film 222 is clearly
 8 as wide as Magni's mattress, and there is no genuine issue of fact regarding the width of film
 9 222.

10 D. Reciting That The Containment Sleeve Is "Pre-Cut" Does Not Make The
 11 Hypothetical Claim Patentable.

12 As set forth above, Dreamwell attempts to fashion a hypothetical claim that covers
 13 the Swirl Wrap method without covering the Magni method by including the term "pre-cut"
 14 in the hypothetical recitation: "inserting said evacuation tube into a pre-cut, solid cover or
 15 barrier of flexible material that substantially covers the exposed surface of the mattress
 16 assembly and which is dimensioned or configured, including by use of tape, adhesives or
 17 fasteners, to retain said compressed mattress assembly in a compressed state for shipment."
 18 (emphasis added).

19 The nebulous "pre-cut" limitation does not distinguish Magni because Magni
 20 discloses that film 222 is pre-cut. Magni states:

21 "At this point, a mechanically or even manually operated cutting means
 22 cuts the film 222 and the end stretch of the film which has been rolled up
 23 together with the mattress is laid down on the outside convolution 222A."
 24 [Magni, 6:25-29]

25 "The end of the film 222 may be approached to the mandrel formed by the
 26 coupled semi-mandrels 207 . . . The end of the film 222 can thus be made
 27 to adhere by pneumatic suction against the mandrel." [Magni, 5:68-6:6]

28 Before the end of the film 222 is approached to the mandrels for suction, the film 222 has
 29 already been mechanically or manually cut either after rolling the previous mattress or in
 30 order to make the spool of film 222. Thus, one end of film 222 is always "pre-cut" before it
 31 is rolled up together with a flattened mattress.

1 Even if Dreamwell is permitted to amend its hypothetical claim to replace the “pre-
2 cut” recitation with one that covers the sheet of the Swirl Wrap method without covering the
3 roll of the Magni method, it is obvious to cut both ends of a sheet of the film 222 of Magni
4 before the rolling step instead of cutting one end before the rolling and the other end after the
5 rolling. It would have been obvious to one of ordinary skill, after reading the Magni patent
6 and learning of Magni’s mechanized, assembly-line method of making the rolled mattress
7 product, to make the same rolled mattress product in a less sophisticated way using a pre-cut,
8 rectangular sheet of film. Zinus submits that taking a mechanized assembly-line
9 manufacturing process for making a product, and dumbing it down, and then making the
10 product on an individual basis in a less mechanized way is obvious. It is especially obvious
11 under the teaching-suggestion-motivation test (TSM) to modify the mechanized process of
12 Magni to be a manual process considering that Magni teaches manually cutting film 222.

13 Once the rolled-up mattress structure of Magni is known to one of ordinary skill in
14 the mattress packaging arts, that person of ordinary skill would realize the most straight-
15 forward way of making the structure, namely placing a compressed mattress on a rectangular
16 sheet of film, and then rolling the compressed mattress and sheet up together. One of
17 ordinary skill would recognize that the mechanized manner of making the product involving
18 rolling the mattress onto a mandrel 207, and dispensing film from a reservoir spool 220, is
19 not the only way that the product could be made. One of ordinary skill would know that the
20 product could, for example, be made by hand in the most straight-forward way by placing a
21 compressed mattress on a pre-cut rectangular sheet of the film, and then manually rolling the
22 mattress and film up together.

23 Zinus has attempted to find legal authority for the broad proposition that manually
24 performing a disclosed mechanical process is just as obvious as providing a mechanical
25 means to replace manual activity that accomplishes the same result, but Zinus has been
26 unable to find such authority. There is, however, authority used by Patent Examiners to
27 reject applications that provide an automatic or mechanical means to replace a manual
28

1 activity in the prior art which accomplished the same result⁸. Zinus supposes that the reason
 2 that authority could not be found for the proposition that manually performing a disclosed
 3 mechanical process is obvious in view of a mechanical means that performs the process
 4 automatically is that making the counter argument borders on frivolous. It is not generally
 5 argued in the Patent Office that dumbing down a process and carrying out the process in a
 6 less efficient manner than the prior art is a non-obvious advance worthy of a patent.

7 E. The “Tape, Adhesives or Fasteners” Recitation Renders The Hypothetical Claim
 8 Invalid Under 35 U.S.C. §112, ¶1.

9 Dreamwell’s hypothetical claim would not have been allowed by the Patent Office
 10 because there is no written description support in the ‘142 Patent for the claim term “tape”,
 11 or for the claim term “adhesives”, or for the claim term “fasteners”. None of the terms
 12 “tape”, “adhesives” or “fasteners” appears in the ‘142 Patent. Moreover, nowhere does the
 13 ‘142 Patent disclose or suggest the use of “tape, adhesives, or fasteners” as part of a
 14 containment sleeve equivalent. Nowhere does the ‘142 Patent disclose or suggest the use of
 15 “tape, adhesives, or fasteners” as part of any object into which the “evacuated tube” is
 16 inserted. No such “tape, adhesives, or fasteners” is illustrated in any diagram. There is
 17 absolutely no objective evidence in the specification of the ‘142 Patent that the inventors of
 18 the ‘142 Patent ever had possession of an invention involving such structures. Accordingly,
 19 had the inventors attempted to insert such words into their claims during prosecution of the
 20 ‘142 Patent, the Patent Office would have responded by rejecting the claims under 35 U.S.C.
 21 §112, first paragraph, for failing to satisfy the written description requirement.

22 F. The Hypothetical Claim is Unpatentable Under 35 U.S.C. §112, ¶2.

23 Dreamwell’s hypothetical claims would be rejected under 35 U.S.C. §112, second
 24 paragraph, as being indefinite for failing particularly to point out and distinctly claim the
 25

26 ⁸ The Manual of Patent Examining Procedure, used by Patent Examiners as a guide and directive on
 27 how to examine patent applications, contains Section 2144.04, III, entitled “Automating A Manual
 28 Activity”. This section explains to Examiners that providing an automatic or mechanical means to
 replace a manual activity which accomplished the same result is not sufficient to distinguish over
 the prior art.

1 subject matter that the applicants regard as their invention. Specifically, claiming in the
2 alternative is indefinite and impermissible. Dreamwell's hypothetical claims use the term
3 "or" in multiple places and do not attempt to place their alternative claiming in a Markush
4 format. For example, Dreamwell's hypothetical claim 1 includes "cover or barrier", "tape,
5 adhesives or fasteners" and "dimensioned or configured". Dreamwell's litigators included
6 the terms "dimensioned or configured" even though the allowed claims recited "dimensioned
7 and configured".

8

9 **IV. CONCLUSION**

10 Dreamwell's overly broad hypothetical claim would not be allowed by the Patent
11 Office because the hypothetical claim: 1) is unpatentable for being obvious under 35 U.S.C.
12 §103 in view of the prior art Magni patent, and 2) is unpatentable under 35 U.S.C. §112, first
13 paragraph, because the specification of the '142 Patent does not provide a written description
14 for the full scope of the hypothetical claim.

15

16 Dated: February 5, 2008

17 By: _____/s/

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19 IMPERIUM PATENT WORKS
20 Attorneys for Plaintiff and Counterdefendant
21 ZINUS, INC.

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